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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/429,331	10/28/1999	LISA A. PAIGE	PAIGE=ID	5796

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EXAMINER

WESSENDORF, TERESA D

ART UNIT PAPER NUMBER

1639

DATE MAILED: 03/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/429,331

Applicant(s)

PAIGE ET AL.

Examiner

T. D. Wessendorf

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 135-139, 142-146, 148-153 and 155-157 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 135-139, 142-146, 148-153 and 155-157 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/13/2005 has been entered.

Status of Claims

Claims 135-139, 142-146, 148-153 and 155-157 are pending and under examination.

Withdrawn Rejection

In view of the amendments to the claims and applicants' arguments, the rejection of the claims under 35 USC § 112, first paragraph is withdrawn. Also, the 35 USC 103 rejection is withdrawn.

Claim Rejections - 35 USC § 112, second paragraph

Claims 135-139, 142-146, 148-153 and 155-157, as amended, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly

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claim the subject matter which applicant regards as the invention and reiterated.

A). Claim 136 is unclear as to what constitutes a panel-based descriptor, especially in the absence of positive definition or recitation in the specification.

Response to Arguments

Applicants argue that the specification at page 45, first full paragraph, as well as at page 46, line 30 up to page 47, line 8 that the description is a numerically expressed characteristic of a compound that distinguishes it from other compounds.

In reply, it is not clear, in the context of claim, the reference to a fingerprint for each member of said plurality of reference compounds, especially when the reference compounds are specifically recited.

B). There is no definition for Xaa in claim 148.

Response to Arguments

Applicants state that Xaa as provided at page 132, lines 1-2 refers to "any amino acid."

In response, it is not clear whether "any amino acid" is a naturally occurring or synthetic amino acid.

The new claims are rejected as follows:

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1. It is not clear whether in step [©], step (2) the same panel members used in step (1)[©] is the same. Furthermore, the essentiality of step (2) of providing a test compound is unclear. Is this test compound different from the reference compounds that bind to the same estrogen receptor? Clarification and/or explanation are required.

2. Claims 137-138 are unclear as to the steps of obtaining panel members as specifically recited in the base claim 135 from the broad component of claim 137.

3. Claim 139 is unclear in the predicting of a test compound in a plurality of different tissues. The base claim does not recite for predicting the biological effect in a plurality of different tissues.

4. Claim 152 is unclear as to the unliganded ER as the base claim does not recite for said term. This rejection has similar import to claim 156.

5. Claim 153 is unclear as to the reference conformations being selected from unliganded receptor. Does this mean that step b of step (1) may or may not contain a bound reference compounds and estrogen receptor?

6. Claim 155 is unclear as to the method by which the recited compounds are distinguished one from the other.

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7. Claim 157 is confusing in reference to Table 10 peptide. The table recites for no modulator. It is unclear whether all the peptides or selected peptides are intended.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Double Patenting

Claims 135-139, 142-146, 148-153 and 155-157 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2 and 6 of U.S. Patent No. 6,617,114 ('114 Patent) for reasons set forth in the last Office action.

Response to Arguments

Applicants will submit a terminal disclaimer upon indication of allowable subject matter in the present application.

In reply in the absence of a terminal disclaimer, the rejection is maintained.

Claims 135-139, 142-146, 148-153 and 155-157 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 27-29, 32, 35 and 37 of the copending Application Nos. and 10/346,162 for reasons advanced in the last Office action.

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Response to Arguments

Applicants will submit a suitable Terminal Disclaimer upon indication of allowable subject matter in the present application.

In response, in the absence of a terminal disclaimer, the rejection is maintained.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to T. D. Wessendorf whose telephone number is (571) 272-0812. The examiner can normally be reached on Flexitime.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (571) 272-0812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TD
T. D. Wessendorf
Primary Examiner
Art Unit 1639

tdw
March 3, 2006